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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,328	06/26/2003	Timothy S. Ranard	020375-028610US	7910
20350	7590	07/13/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			TAYLOR, APRIL ALICIA	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/609,328

Applicant(s)

RANARD ET AL.

Examiner

April A. Taylor

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/27/03; 6/26/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because every line, number, and letter must be durable, clean, sufficiently dense and dark, and uniformly thick and well defined. The sheets of drawings should be numbered in consecutive Arabic numerals. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The disclosure is objected to because of the following informalities: Substitute "multiple of the functions" with -- multiple of functions -- (see page 5, line 32).

Appropriate correction is required.

***Claim Objections***

3. Claims 5 and 13 are objected to because of the following informalities:

Re claim 5: Substitute "tho" with -- the -- (see line 3).

Re claim 5: Substitute "the bundle" with -- a bundle -- (see line 1).

Re claim 5: Substitute "the process flow" with -- a process flow -- (see line 2).

Re claim 13: Substitute "adapted to read" with -- for reading -- (see line 2)

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 9-11, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Masada (US 5,012,074).

Re claims 1 and 2: Masada teaches a method for producing a plurality of transaction cards comprising assigning a unique manufacturer's identification code,

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which serves as a reference number as claimed in claim 1, to each of the transaction cards; fabricating each of the transaction cards in accordance with a specification; and comparing the reference number assigned to each of the transaction cards with a database of previously assigned reference numbers; and wherein the plurality of transaction cards comprises a stored value card (see col. 1, line 51 to col. 4, line 68).

Re claim 3: Masada teaches wherein comparing the reference number assigned to each of the transaction cards is performed for a bundle having a predetermined number of transaction cards (see col. 1, line 51 to col. 4, line 68).

Re claim 5: Masada further teaches preventing the bundle from progressing to a subsequent stage in the process flow until a preceding stage in the flow is completed (see col. 1, line 51 to col. 4, line 68).

Re claim 9: Masada teaches wherein the database includes records for previously assigned reference numbers for a plurality of different card issuers (see col. 1, line 51 to col. 4, line 68).

Re claims 10, 11, 17, and 18: Masada teaches a system for producing transaction cards comprising:

- a plurality of stations having mechanism for implementing a production function;

- an operator interface;

- a controller for controlling the stations and the operator interface;

- a memory coupled to the controller comprising a computer-readable medium having a computer-readable program, the computer-readable program including:

  - instructions for assigning a reference number to the transaction cards;

instructions for fabricating the transaction cards at the plurality of stations in accordance with the production function; and

instructions for subsequently comparing the reference number assigned to each of the transaction cards with a database of previously assigned reference numbers;

wherein at least one of the transaction cards comprises a stored value card; and

wherein the database includes records for previously assigned reference numbers for a plurality of difference card issuers. (See col. 1, line 51 to col. 4, line 68)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 4, 6-8, 12-16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masada (US 5,012,074). The teachings of Masada have been discussed above.

Re claim 4: Masada fails to specifically teach or fairly suggest removing the bundle from a process flow in response to identification that the reference number for at least one of the transaction cards comprised by the bundle is a duplicate of one of the previously assigned reference numbers. However, it would have been obvious to artisan of ordinary skill in the art at the time the invention was made to employ the step of removing the bundle from a process flow in response to identification that the reference number for at least one of the transaction cards is a duplicate of one of the previously assigned reference numbers in order to prevent a duplicate card from being sent out and used for purchasing.

Re claims 6, 7, 13-15, and 19: Masada fails to specifically teach or fairly suggest wherein fabricating each of the transaction cards further includes recording an identity of an operator and wherein comparing the reference number assigned to each of the transaction cards includes recording an identity of an operator. However, it would have been obvious to artisan of ordinary skill in the art at the time the invention was made to employ the step recording an identity of an operator in order to effectively and quickly identify the authorize operator in case of any errors reported later.

Re claims 8, 16, and 20: Masada fails to teach or fairly suggest performing an audit for at least one of the transaction cards to identify a first operator responsible for at least a portion of the fabricating step and a second operator responsible for at least a

portion of the comparing step. However, it would have been obvious to artisan of ordinary skill in the art at the time the invention was made to employ the step of performing an audit for at least one of the transaction cards in order to effectively identify the operators that are responsible for the production of the cards in case of any fraudulent use of the cards are reported.

Re claim 12: Masada fails to teach or fairly suggest wherein at least one of the stations includes an inkjet printer, an embosser, or a thermal printer. However, it would have been obvious to artisan of ordinary skill in the art at the time the invention was made to employ a printer or embosser in order to provide account data on the face of the card.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 6,719,198 to Bretl et al

US Pat. No. 6,505,171 to Cohen et al

US Pat. No. 6,402,028 to Graham, Jr. et al

US Pat. No. 5,721,768 to Stimson et al

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Taylor whose telephone number is (571) 272-2403. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.taylor@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AAT  
09 July 2004



**THIEN M. LE**  
**PRIMARY EXAMINER**